

UNITED STATES DISTRICT COURT

for the

District of Columbia

TELES AG AND SIGRAM SCHINDLER
BETEILIGUNGSGESELLSCHAFT MBH

Plaintiff

v.

DAVID J. KAPPOS, in his official capacity as in his official capacity
as Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office,

Defendant

Case: 1:11-cv-00476

Assigned To : Howell, Beryl A.

Assign. Date : 3/4/2011

Description: General Civil

SUMMONS IN A CIVIL ACTION

To: *(Defendant's name and address)*

David J. Kappos
Acting Director of the US Patent & Trademark Office
Madison Building East, Room 10B20
600 Dulany Street
Alexandria, VA 22314

A lawsuit has been filed against you.

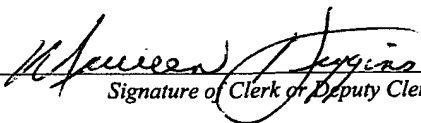
Within ~~21~~ days after service of this summons on you (not counting the day you received it) — or 60 days if you are the United States or a United States agency, or an officer or employee of the United States described in Fed. R. Civ. P. 12 (a)(2) or (3) — you must serve on the plaintiff an answer to the attached complaint or a motion under Rule 12 of the Federal Rules of Civil Procedure. The answer or motion must be served on the plaintiff or plaintiff's attorney, whose name and address are:

James W. Dabney, Esq.
Fried, Frank, Harris, Shriver & Jacobson LLP
One New York Plaza
New York, N.Y. 10004

If you fail to respond, judgment by default will be entered against you for the relief demanded in the complaint. You also must file your answer or motion with the court.

CLERK OF COURT

Date: 03/04/2011


Signature of Clerk or Deputy Clerk

Civil Action No. _____

PROOF OF SERVICE

(This section should not be filed with the court unless required by Fed. R. Civ. P. 4 (l))

This summons for *(name of individual and title, if any)* _____
was received by me on *(date)* _____.

☐ I personally served the summons on the individual at *(place)* _____
on *(date)* _____; or

☐ I left the summons at the individual's residence or usual place of abode with *(name)* _____
_____, a person of suitable age and discretion who resides there,
on *(date)* _____, and mailed a copy to the individual's last known address; or

☐ I served the summons on *(name of individual)* _____, who is
designated by law to accept service of process on behalf of *(name of organization)* _____
on *(date)* _____; or

☐ I returned the summons unexecuted because _____; or

☐ Other *(specify)*:

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ 0.00.

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc:

4. This action arises under the Patent Act of 1952, as amended, 35 U.S.C. §§ 1-376.
5. The Court has subject matter jurisdiction to hear this action under 28 U.S.C. § 1331, 5 U.S.C. § 706, and 35 U.S.C. § 306.

CLAIM FOR RELIEF

6. TELES and SSBG collectively own all substantial rights in U.S. Patent No. 6,954,453 B1 entitled "Method for Transmitting Data in a Telecommunications Network and Switch for Implementing Said Method" (the "Schindler '453 Patent").

7. The Schindler '453 Patent issued October 11, 2005, on the basis of an application filed October 7, 1997, which claimed priority to a German application filed October 7, 1996.

8. The Schindler '453 Patent discloses and claims, among other things, switching apparatus for routing a telephone call from a first end terminal to a second end terminal, selectively by line switching and packet switching.

9. Between August 30, 2007, and January 7, 2011, the United States Patent and Trademark Office ("PTO") conducted an *ex parte* reexamination of claims 34-36 and 38 of the Schindler '453 Patent under the provisions of Chapter 30 of the Patent Act, 35 U.S.C. §§ 301-307.

10. On or about January 7, 2011, the United States Patent and Trademark Office ("PTO") affirmed a final rejection of claims 34-36 and 38 of the Schindler '453 Patent on the basis that the invention defined by those claims assertedly "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a).

11. Evidence concerning (i) whether there was a long-felt but unsolved need for inventions claimed in the Schindler '453 Patent, (ii) whether others addressed and failed to solve problem(s) addressed by inventions claimed in the Schindler '453 Patent, (iii) whether commercial products have achieved commercial success that is attributable, in whole or in part, to use of one or more inventions claimed in the Schindler '453 Patent, or (iv) whether others have recog-

nized the non-obviousness of inventions claimed in the Schindler '453 Patent, is relevant to the obviousness or nonobviousness of the switching apparatus defined by claims 34-36 and 38 of the Schindler '453 Patent.

12. On information and belief, information and documents relevant to the validity of claims in the Schindler '453 Patent, including commercial success, long felt but unsolved need, failures of others, and recognition of patentability by others in the field, are held by third parties who are located in one or more districts of the United States.

13. Under the statutes and rules that govern the conduct of *ex parte* reexamination proceedings in the PTO, TELES and SSBG did not have any access to subpoenas under 35 U.S.C. § 24 or any other coercive discovery mechanism by which non-public information relevant to the validity of claims in the Schindler '453 Patent, such as software utilized to configure third-party switching apparatus believed to embody the claimed invention(s), could be discovered and presented to the PTO.

14. 35 U.S.C. § 306 provides: "The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of Section 134 of this title, and may seek court review under the provisions of Sections 141-145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

15. Sections 141-145 of Title 35, United States Code, provide two alternative forms of "court review." 35 U.S.C. § 141 provides that a dissatisfied patent applicant may "appeal" from an adverse PTO decision to the Court of Appeals for the Federal Circuit. In an "appeal" taken under 35 U.S.C. § 141, the appellate court reviews the decision from which the appeal is taken "on the record before the Patent and Trademark Office." 35 U.S.C. § 144.

16. 35 U.S.C. § 145, by contrast, provides that a dissatisfied patent applicant "may have remedy by civil action against the Director in the United States District Court for the District of Columbia." In contrast with the position of an appellant in an "appeal" taken under 35

U.S.C. § 141, the plaintiff in a “civil action” brought under 35 U.S.C. § 145 is not limited to the record that was made before the PTO, but may seek discovery and introduce new evidence in support of any issue that was raised before the PTO.

17. When, in a civil action brought under 35 U.S.C. § 145, new evidence is introduced that is relevant to an issue that was raised before the PTO, a district court must decide the issue *de novo*.


18. The PTO’s conclusion that claims 34-36 and 38 of the Schindler ‘453 Patent recite subject matter that “would have been obvious of the time the invention was made to a person having ordinary skill in the art,” 35 U.S.C. § 103(a), is erroneous and should be reversed.

WHEREFORE, TELES and SSBG pray that the Court:

- (i) Declare, adjudge, and decree that the individuals named as inventors in the Schindler ‘453 Patent were entitled to receive, and properly did receive, a patent for the subject matter described in claims 34-36 and 38 of the Schindler ‘453 Patent;
- (ii) Declare, adjudge, and decree that the PTO’s final agency action in Appeal No. 2010-00115 is erroneous, contrary to law, and should be reversed insofar as it affirmed the final rejection of claims 34-36 and 38 of the Schindler ‘453 Patent;
- (iii) Direct the defendant to issue a reexamination certificate under 35 U.S.C. § 307 confirming the patentability of claim 34-36 and 38 of the Schindler ‘453 Patent; and
- (iv) Grant such other and further relief as the Court may deem just and proper.

Dated: March 4, 2011

FRIED, FRANK, HARRIS, SHRIVER
& JACOBSON LLP

By 
James W. Dabney (D.D.C. Bar # NY0036)
Douglas W. Baruch (D.C. Bar # 414354)

One New York Plaza
New York, New York 10004-1980
Telephone: (212) 859-8000
Facsimile: (212) 859-4000
Email: james.dabney@friedfrank.com

801 17th Street, NW
Washington, D.C. 20006
Telephone: (202) 639-7000
Facsimile: (202) 639-7003
Email: douglas.baruch@friedfrank.com

Attorneys for Plaintiffs

8010590

One New York Plaza
New York, New York 10004-1980
Telephone: (212) 859-8000
Facsimile: (212) 859-4000
Email: james.dabney@friedfrank.com

801 17th Street, NW
Washington, D.C. 20006
Telephone: (202) 639-7000
Facsimile: (202) 639-7003
Email: douglas.baruch@friedfrank.com

Attorneys for Plaintiffs

8010590

UNITED STATES DISTRICT AND BANKRUPTCY COURTS
FOR THE DISTRICT OF COLUMBIA

**INITIAL ELECTRONIC CASE FILING
ORDER**

(Does not apply to pro se filers)

Subsequent filings in this case must be made electronically using the Court's Electronic Case Filing System (ECF) pursuant to Local Civil Rule 5.4.

ORDERED that counsel shall:

- Submit in paper, the original and copy of the complaint/notice of removal/petition for writ of habeas corpus and any accompanying papers (**not including summons and civil cover sheets**). Additionally, litigants are hereby required to provide those filings in PDF format on a floppy disk or CD-Rom compact disk. The disk should be clearly labeled with the case number (if known) and the name of the parties. If unable to deliver the filing on a disk at the time of the new case filing, counsel should e-mail the initiating document and accompanying papers to dcd_cmecl@dcd.uscourts.gov by the close of business the day the new case was filed. Failure to supply electronic copies of the new case in a timely manner, will result in the attorney's name being added to the attorney non-compliant list and shared with the Court's ECF Judge's Committee. Regardless of what option counsel chooses, the complaint/notice of removal/petition for writ of habeas corpus and accompanying papers must come to the Court as PDF documents. Each exhibit to the new case shall be in a separate PDF file. Failure to submit PDF versions of the initiating documents will delay the opening of the case in ECF.
- Register, if not previously registered, to become an electronic filer by completing and returning the enclosed ECF Registration form found on the Court's Website at www.dcd.uscourts.gov. The login and password are case specific and can be used for all cases.
- All subsequent filings must be made electronically.
- Have a PACER (Public Access to Court Electronic Records) account, in order to view dockets and documents. Call 800-676-6856 or visit www.pacer.psc.uscourts.gov for additional information.
- Schedule a training class at the Courthouse by going to the Court's ECF Internet Website www.dcd.uscourts.gov/ecf.html. Also, filing instructions and an interactive tutorial can be found at this Internet Website.
- Pursuant to Local Civil Rule 5.4(b)(2), a pro se litigant may file a motion requesting permission to file documents electronically. See the rule for specific directions and requirements.

HOWELL, J. BAH

UNITED STATES DISTRICT JUDGE